

## REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 7, 2005. Upon entry of the amendments in this response, claims 1 and 3 - 24 remain pending. In particular, Applicants have amended claim 1, and have canceled claim 2 without prejudice, waiver, or disclaimer. Applicants have canceled claim 2 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of this canceled claim in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### Rejections Under 35 U.S.C. §102

The Office Action indicates that claims 1 and 7 - 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by *Siegel*. Applicants respectfully traverse the rejection.

In this regard, Applicants have amended claim 1 to recite:

1. A method for transferring data between a host device and a storage medium, comprising:
  - receiving from the host device a command to transfer data between the host device and the storage medium;
  - storing in a first register a value for tracking a number of data units* that have been transferred into a buffer but that have not yet been transferred out of the buffer;
  - modifying the value* contained in the first register in response to a transfer of a data unit into the buffer;
  - modifying the value* contained in the first register in response to a transfer of a data unit out of the buffer;
  - storing in a second register a value for incrementing the value contained in the first register; and*
  - incrementing the value contained in the first register by the value contained in the second register.*

(Emphasis Added).

Applicants respectfully assert that *Siegel* is legally deficient for the purpose of anticipating claim 1. Specifically, Applicants respectfully assert that *Siegel* does not teach or otherwise disclose at least the features/limitation emphasized above in claim 1. Notably, Applicants have amended claim 1 to incorporate limitations previously recited in claim 2. With respect to claim 2, which is canceled in this response, the Office Action indicates that *Siegel* does not teach the use of a second register as recited. Therefore, Applicants respectfully assert that the rejection is improper and requests that the rejection of claim 1 be removed.

Since claims 7 - 9 are dependent claims that incorporate the limitations of claim 1, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other limitations that can serve as an independent basis for patentability.

#### **Rejections Under 35 U.S.C. §103**

The Office Action indicates that claims 2 – 6 and 10 - 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Siegel* in view of *Gharachorloo*. With respect to claim 2, Applicants have canceled this claim and respectfully assert that the rejection of this claim has been rendered moot. With respect to the remaining claims, Applicants respectfully traverse the rejection.

In this regard, Applicants respectfully assert that *Gharachorloo* is prior art with respect to this application only under 35 U.S.C. 102(e). In particular, Applicants have reviewed the parent application and the provisional application upon which *Gharachorloo* claims priority, and it appears that the subject matter relied upon in the Office Action for rejecting the pending claims is not supported by the provisional application. Thus, the

effective filing date of *Gharachorloo* with respect to the pending claims is June 11, 2001, which is less than one year prior to the filing date of this application (March 6, 2002).

Since *Gharachorloo* and the present application are owned by the same entity, Applicants respectfully request that *Gharachorloo* be removed under 35 U.S.C. 103(c) as a reference for rejecting the pending claims. Specifically, Applicants respectfully assert that the subject matter of *Gharachorloo* is only prior art under 35 U.S.C. 102(e) and that the subject matter and the claimed invention were, at the time of the invention was made, owned by the same person. Therefore, Applicants respectfully request that *Gharachorloo* be removed and that the pending claims be placed in condition for allowance.

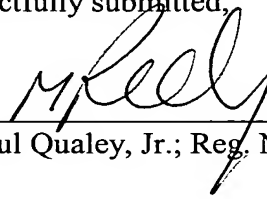
#### **Cited Art Made of Record**

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

### CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

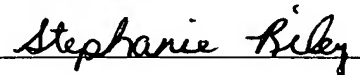
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 7/6/05.

  
Signature